

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of	)	<b>MAIL STOP APPEAL BRIEFS - PATENTS</b>
Takeo Katsuda	)	
Application No.: 09/880,039	)	Group Art Unit: 2145
Filed: June 14, 2001	)	Examiner: Thomas Duong
For: APPARATUS, PORTABLE TERMINAL	)	Confirmation No.:
UNIT, AND SYSTEM FOR	)	
CONTROLLING E-MAIL, AND ITS	)	
METHOD, COMPUTER-READABLE	)	
RECORDING MEDIUM AND	)	
PROGRAM PRODUCT FOR	)	
PROCESSING E-MAIL	)	

**REPLY BRIEF**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This reply brief is being filed in response to the Examiner's Answer dated December 29, 2008.

In responding to the arguments presented in Appellants' Appeal Brief, the Answer employs overly broad interpretations of the teachings of Miller that ignore the specific language of the claims, in an attempt to support the rejections.

**I. Miller does not anticipate the claimed features of claims 14 and 31.**

The Patent Office (PTO) contends that Miller teaches "an E-mail transmitting device transmitting to said portable terminal unit an E-mail identifying multiple prospective image output devices", as recited in claims 14 and 31. The Examiner's Answer, on pages 10-11, provides that "Miller discloses in figures 4(j), 4(n), 4(q) and 4(t) the possible delivery methods determined by the system", and concludes that

"Miller teaches of the system presenting the subscriber with the system selected outputting methods".

While Miller presents the subscriber with a menu for selecting a retrieval method, as illustrated in Figure 4(n), Miller does not disclose "*transmitting an E-mail to the portable terminal unit identifying multiple prospective image output devices*". The menu presented on the handset is not an E-mail transmitted to the handset.

"All words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP 2143.01 citing *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Accordingly, the PTO cannot ignore the language "**transmitting an E-mail to the portable terminal unit** identifying multiple prospective image output devices" in the claims.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, for at least the reasons stated above, Miller does not anticipate claims 14 and 31.

## **II. Miller does not teach the claimed features of claims 38, 40 and 42.**

The PTO contends that Miller discloses, "sending an E-mail to said destination containing a notification of the selected image output device", as recited in claims 38, 40 and 42. The Examiner's Answer, on page 12, provides,

Miller teaches of an environment where an email addressed to a mobile subscriber is received and delivered to the addressee, the addressee is located and finally the intended email is displayed to the subscriber or outputted to a device according to subscriber's preference.

The PTO relies upon column 3, lines 33-38 of Miller as a basis for contending that Miller teaches the aforementioned feature. However, the relied upon section of

Miller teaches a display subsystem outputting ***a notification that a message has been received***. This is not analogous to, "sending an E-mail to said destination containing a notification of the selected image output device". Miller's message **does not** contain ***a notification of the selected image output device***.

As noted above, the PTO must consider all the words in a claim. The Examiner's Answer fails to provide any facts, rationale or reasoning to establish that Miller teaches the abovementioned feature. Accordingly, Miller does not teach the claimed features of claims 38, 40 and 42.

**III. Miller does not teach the claimed features of claims 44-46.**

The PTO, for the first time, has addressed the claimed features of claim 44-46. The Examiner's Answer, on page 13, provides that "Miller teaches of a controller appropriately handling the received messages and notifying the subscriber's handset as appropriate". The PTO relies on column 9, lines 37-46 of Miller as a basis for teaching the subject matter recited above.

However, claim 44 recites in part, "a processor that is responsive to receipt of an E-mail addressed to a certain destination through the communication interface, for generating at least one E-mail containing a notification of the receipt of the E-mail and information on at least one output device to which at least part of the E-mail is to be outputted".

Miller discloses in column 9, lines 37-46 that the service controller handles received mail according to filtering and forwarding rules that are pre-established by a service subscriber and transmitting a notification of the mail receipt to the subscriber's handset after the appropriate handling is determined.

Miller's teachings fail to disclose the service controller generating an E-mail containing receipt notification of the E-mail and information on at least one output device to which part of the E-mail is to be outputted. Miller is silent as to providing information on an output device which part of the E-mail is to be output from. Further, Miller does not disclose the filtering and forwarding rules including providing information on an output device, which part of the E-mail is to be output from, in an E-mail containing receipt notification.

Consequently, as Miller does not teach the aforementioned feature, Miller also does not teach the claimed features of claims 45 and 46.

In summary, the rejection employs overly broad interpretations of the reference that ignore the specific language of the claims, in an attempt to support the rejections. When viewed accurately, it is apparent that not all of the claim recitations are present or apparent from the applied art. As such, a prima facie case of anticipation has not been established for claims 14 and 31 and a prima facie case of obviousness has not been established for claims 38, 40, 42 and 44-46.

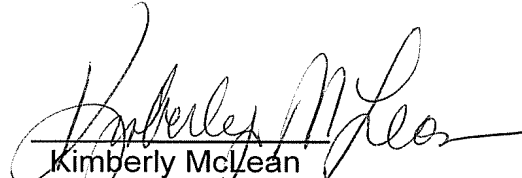
Reversal of the present rejections is respectfully submitted to be in order.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: February 23, 2009

By:

  
Kimberly McLean  
Registration No. 62378

P.O. Box 1404  
Alexandria, VA 22313-1404  
703 836 6620 - Customer No. 21839